

1 HONORABLE RICHARD A. JONES
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7 UNITED STATES DISTRICT COURT
8 WESTERN DISTRICT OF WASHINGTON
9 AT SEATTLE

10 BLUTOOTH SIG, INC., a Delaware
11 corporation,

12 Plaintiff,

13 v.

14 FCA US LLC, a Delaware limited liability
15 company,

16 Defendant.

17 Case No. 2:18-cv-01493-RAJ

18 **ORDER GRANTING IN PART
19 AND DENYING IN PART
PLAINTIFF'S MOTION TO
COMPEL**

20 **I. INTRODUCTION**

21 This matter is before the Court on Plaintiff's motions to compel. Dkt. # 44. For the
22 reasons below, the Court **GRANTS in part** and **DENIES in part** the motions.

23 **II. BACKGROUND**

24 Plaintiff Bluetooth SIG, Inc. ("Plaintiff" or "SIG") owns trademarks for
25 BLUETOOTH, BLUETOOTH & B Design, and "B Design" (collectively, the
26 "BLUETOOTH Marks"). Dkt. # 44. To date, the SIG has granted licenses to use the
27 BLUETOOTH Marks to more than 34,000 member companies. *Id.*

28 Defendant FCA US LLC ("Defendant" or "FCA") is a North American automotive
29 manufacturer of brands such as Fiat, Chrysler, Dodge, Jeep, and Ram. *Id.* FCA claims
30 that among the myriad of components in its automobiles are radio head unit components,
31 some of which are Bluetooth-enabled. *Id.* FCA claims to have purchased these radio head

1 unit components from various third-party suppliers that had already secured licenses from
2 SIG. *Id.*

3 SIG brings claims against FCA for (i) trademark infringement, counterfeiting, and
4 dilution; (ii) unfair competition; (iii) and violations of the Washington Consumer
5 Protection Act. Dkt. # 1. On December 10, 2018, SIG propounded its First Set of Requests
6 for Production on FCA, and requested, among other things, the production of financial
7 documents reflecting FCA's wholesale and retail fees or prices charged for its products,
8 FCA's gross sales revenues, profits, and costs, and FCA's volume for each unit sold on a
9 monthly basis since each such good or service was first offered using the SIG's marks (the
10 "Requested Documents"). Dkt. # 44. The parties dispute the relevance of the requested
11 documents. *Id.*

12 III. DISCUSSION

13 The Court has broad discretion to control discovery. *Avila v. Willits Envtl.*
14 *Remediation Trust*, 633 F.3d 828, 833 (9th Cir. 2011). That discretion is guided by several
15 principles. Most importantly, the scope of discovery is broad. A party must respond to
16 any relevant discovery request that is not privileged and that is "reasonably calculated to
17 lead to the discovery of admissible evidence." Fed. R. Civ. P. 26(b)(1). The Court,
18 however, must limit discovery where it can be obtained from some other source that is
19 more convenient, less burdensome, or less expensive, or where its "burden or expense . . .
20 outweighs its likely benefit, considering the needs of the case, the amount in controversy,
21 the parties' resources, the importance of the issues at stake in the action, and the importance
22 of the discovery in resolving these issues." Fed. R. Civ. P. 26(b)(2)(C)(i), (iii).

23 A. Disputed Discovery Request

24 i. Request for Production No. 5

25 In its Request for Production ("RFP") No. 5, SIG seeks "DOCUMENTS sufficient
26 to show the wholesale and retail fees or prices charged for each of YOUR GOODS AND
27 SERVICES." Dkt. # 44 at 5.

1 Here, SIG claims that documents relating to the wholesale and retail fees or prices
2 charged by FCA for its products are integral to the SIG’s ability to perform an accounting
3 and compute its damages. *Id.* at 6. FCA objects to this request for production, arguing that
4 discovery of FCA’s financial information as to its automobiles is not proportional to the
5 needs of the case. *Id.* at 7-8. The Court disagrees with FCA’s assertion that SIG may not
6 be awarded discovery without first presenting evidence of the “commercial magnetism” of
7 the BLUETOOTH marks. *Id.* FCA appears to admit the use of BLUETOOTH marks to
8 inform consumers that the radio head unit components installed in FCA’s automobiles use
9 Bluetooth technology. *Id.* The prices charged by FCA for products alleged to be using or
10 advertising the use of BLUETOOTH-equipped products is reasonably relevant to SIG’s
11 claims. Fed. R. Civ. P. 26(b)(1). However, the Court will **DENY** SIG’s motion to compel
12 production because RFP No. 5, as written, is overly broad and unduly burdensome.

13 **ii. Request for Production No. 15**

14 SIG seeks “DOCUMENTS sufficient to show the gross sales revenues, profits, and
15 costs for each of YOUR GOODS AND SERVICES on a monthly basis since each such
16 good or service was first offered USING the BLUETOOTH MARKS.” Dkt. # 44 at 9.

17 SIG claims that the documents sought by this request are directly relevant to the
18 SIG’s computation of damages, a portion of which will comprise of disgorgements of
19 FCA’s profits. *Id.* at 10. Moreover, SIG argues request is as narrowly tailored, demanding
20 only those documents from the time period from which FCA began misappropriating the
21 SIG’s BLUETOOTH Marks. *Id.* FCA reiterates its contention that discovery should not
22 be rewarded without first presenting evidence of the “commercial magnetism” of the
23 BLUETOOTH marks. *Id.* at 12. For the reasons previously stated, this argument is
24 unpersuasive. Accordingly, the Court **GRANTS** SIG’s motion to compel.

25 **iii. Request for Production No. 16**

26 SIG seeks “DOCUMENTS sufficient to show the volume of each of YOUR
27 GOODS AND SERVICES sold on a monthly basis since each such good or service was

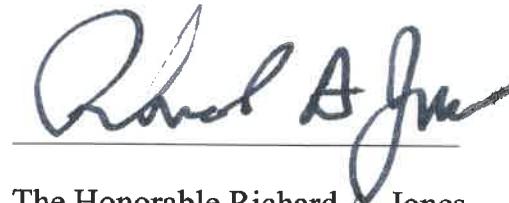
1 first offered USING the BLUETOOTH MARKS.” *Id.* at 13.

2 SIG claims that the documents sought by this request are directly relevant to the
3 SIG’s computation of damages, a portion of which will comprise of disgorgements of
4 FCA’s profits. *Id.* at 15. FCA again claims that discovery should not be rewarded without
5 first presenting evidence of the “commercial magnetism” of the BLUETOOTH marks. For
6 the reasons previously stated, this argument is unpersuasive. Accordingly, the Court
7 **GRANTS** SIG’s motion to compel.

8 **IV. CONCLUSION**

9 For the reasons stated above, the Court **GRANTS** in part and **DENIES** in part
10 SIG’s motions to compel. Dkt. # 44.

11 DATED this 4th day of October, 2019.
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16 The Honorable Richard A. Jones
17 United States District Court Judge
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